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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,859	04/10/2001	Umesh Amin	12177/28302	6957
23838	7590	06/18/2004	EXAMINER	
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			NGUYEN, LEE	
			ART UNIT	PAPER NUMBER
			2682	

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,859

Applicant(s)

AMIN ET AL.

Examiner

LEE NGUYEN

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 4-6,9,10,21-38 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,7,8,11-20,39-42 and 44-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 4-6, 9-10, 21-38, 43 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/26/2004.

Information Disclosure Statement

2. The IDS filed 6/14/2001 duplicates the IDS filed 4/10/2001.

Therefore, the duplicated is not considered.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-3, 7-8, 11-20, 39-42, 44-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,256,518. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-9 of U.S. Patent'518 encompass the limitations as claimed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the

contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-3, 7-8, 11-20, 39-42, 44-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tam (US 5,526,403) in view of Heo (US 5,400,388) submitted by Applicant.

Regarding claim 1, Tam teaches a system to provide power to a communications unit, the system comprising: a first communications network (cellular network) to engage in communications with the communications unit; and a second communications network (land-based public switched telephone network to provide communication to the communications unit (col.3, 25-47, 60 through col. 4, 5, fig. 1). The communication unit of Tam is powered by AC power supply 27 (fig. 1). Tam fails to teach that the second communication network can provide power to the communication unit in the event of power outage. According to Heo, land-based public switched telephone network to provide power to the communications unit in the event of

power outage (col. 3, 24-30, 58-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Heo to the system of Tam in order to continuously provide power to the communication unit when there is no power supply in the communication unit in the event of power outage.

Regarding claim 2, Tam as modified also teaches that the first communications network comprises a wireless communications network, and the second communications network unit comprises a local exchange carrier network (col. 3, 25-31 of Tam).

Regarding claim 3, Tam as modified also teaches that the communications unit comprises a fixed wireless communications unit (col. 3, 25-31 of Tam).

Regarding claim 7, the claim is interpreted and rejected for the same reason as set forth in claim 1, which includes a wireless switch (53, fig. 4 of Tam).

Regarding claim 8, the claim is interpreted and rejected for the same reason as set forth in claim 3.

Regarding claim 11, Tam as modified also teaches that wireless

communications unit comprises a wireless communications handset (col. 3, 25-47 of Tam).

Regarding claim 12, Tam as modified teaches a base station coupled to the wireless switch, the base station to engage in wireless communications with the wireless communications unit (fig. 4, 51 of Tam).

Regarding claim 13, Tam as modified does not explicitly teaches that the base station and the wireless communications unit are to engage in wireless communications pursuant to a wireless communications protocol selected from the group consisting of an Advanced Mobile Phone Service wireless communications protocol, an Interim Standard 41 wireless communications protocol, an Interim Standard 54 wireless communications protocol, an Interim Standard 55 Time Division Multiple Access wireless communications protocol, an Interim Standard 95 Code Division Multiple Access wireless communications protocol, GSM, 3G, WAP, GPS and an Interim Standard 136 Time Division Multiple Access wireless communications protocol. It is taken official notice that a cellular telephone system that can be implemented in said protocols is

conventionally well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the protocols as claimed in order to comply with the system to be implemented.

Regarding claims 14, 16, the claims are interpreted and rejected for the same reason as set forth in claims 7, 12.

Regarding claim 15, the claim is interpreted and rejected for the same reason as set forth in claim 3.

Regarding claim 17, the claim is interpreted and rejected for the same reason as set forth in claim 13.

Regarding claim 18, the claim is interpreted and rejected for the same reason as set forth in claim 7. Tam further teaches coupling the fixed wireless communication unit to a landline receptacle unit (fig. 4, 50 of Tam).

Regarding claim 19, Tam as modified by Heo teaches that the fixed wireless communications unit is charged by receiving power from the landline (see the rejection of claim 1).

Regarding claim 20, Tam as modified also teaches that the wireless communications are cellular communications (col. 3, 25-31 of Tam).

Regarding claim 39, the claim is interpreted and rejected for the same reasons as set forth in claim 20.

Regarding claim 40, Tam as modified also teaches that the cellular communication device is a transceiver (fig. 4, 12 of Tam).

Regarding claims 41-42, Tam as modified also teaches that said wireless communication device 10 is adapted to communicate with a base station 51 according to at least one cellular communications protocol 53 (fig. 4 of Tam).

Regarding claims 44-45, the claims are interpreted and rejected for the same reason as set forth in claims 39-40.

Regarding claim 46, Tam as modified by Heo also teaches that said first network is a wireless network comprising a fixed base station and a wireless communication device (col. 3, 4-7 of Heo).

Regarding claim 47, Tam as modified by Heo also teaches that said power supply is coupled to the communication device (fig. 1 of Heo).

Regarding claim 48, Tam as modified by Heo also teaches that said power supply is integrated with the communication device (fig. 1 of Heo).

Regarding claim 49, the claim is interpreted and rejected for the same

reason as set forth in claim 1.

Regarding claim 50, the claim is interpreted and rejected for the same reason as set forth in claim 44, 49. Tam as modified by Heo also teaches a converter (col. 3, 8-57 of Heo).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lee Nguyen 6/11/04
LEE NGUYEN
Primary Examiner
Art Unit 2682